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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,560	04/26/2001	David Mallis	09432/168002	9436

22511 7590 05/10/2004

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HOUSTON, TX 77010

EXAMINER
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TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/843,560

**Applicant(s)**

MALLIS, DAVID

**Examiner**

A. Dexter Tugbang

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The applicant's amendment filed on 2/19/04 has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

3. Claim 24 is objected to because of the following informalities: the language of Claim 24 is awkwardly worded and should be changed as follows. The term --of-- should be inserted after "the other" (line 2). Each occurrence of "a shoulder" (both occurrences on line 2) should be replaced with --the shoulder--. A comma --,-- should be inserted after "the pin member" (line 3). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. With respect to at least Claims 1-22, the rejection in the previous Office Action, dated 11/19/03, is hereby repeated below for the applicant's convenience.
5. Claims 1-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Timme 4,438,953.

Regarding Claims 1, 10, 21 and 22, Timme discloses a method of manufacturing a wear indicator and a threaded pipe connection comprising: a pin member 11 (in Fig. 2) having external threads 15 increasing in width in one direction; a box member 35 (in Fig. 3) having internal threads 43 increasing in width in an opposite direction so that complementary internal threads and external threads move into engagement upon a make-up connection; and a wear

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indicator that extends from a shoulder (recess 23 and bevel 19) of the pin member 11 (see Fig. 4) where the connection wear is indicated by the contact between the wear indicator 17 and a shoulder 39 of the box member 35 (see col. 2, lines 60-66).

Regarding Claims 2-9 and 11-18, the shoulder of the pin member 11 can be read alternatively as either an "internal shoulder" or an "external shoulder"; and the shoulder 39 of the box member 35 can be read alternatively as an "internal shoulder" or an "external shoulder".

When the pin member 11 and the box member 35 form the make-up connection, the wear indicator 17 can be said to be disposed on or extending from both the external or internal shoulders of either the pin member and the box member.

Regarding Claim 19, the means-plus-function language of a "means for indicating connection wear" is read as the structure of the wear indicator 17 in Timme.

Regarding Claim 20, the wear indicator 17 of Timme is considered to be a circumferential extension from the body 13 (see Fig. 4).

Regarding Claim(s) 24, the wear indicator on the pin member of Timme does not contact the shoulder of the box member when the connection of the pin member and box member is first connected. The recitation of "first connected" in Timme is read as the moment when the ends of the threads of the pin member and the ends of the threads of the box member first contact one another, which at that moment, would include an space or clearance between each of the shoulders of the pin member and box member.

*Response to Arguments*

6. The applicant's arguments with respect to claims 1-22 in the response filed on 2/19/04 have been fully considered, but have not been deemed to be found as persuasive.

In regards to the merits of Timme, the applicant believes that Timme does not teach the structure of the claimed "wear indicator" because the wear indicator of Timme does not extend from a "shoulder".

The examiner most respectfully disagrees because the wear indicator does extend from a shoulder. The "wear indicator" of Timme is read as the end or edge surface area of element 17 and the "shoulder" is read as the cross-hatched region of the pin member to the left of the beveled edge 19. This edge surface area of element 17, projects, or extends from, the remaining portion of the cross-hatched region (left of the beveled edge 19) of the pin member because this projection or extension is caused by the recess 23 and beveled edge 19 formed on either side of the edge surface area. In other words, the surface of the wear indicator 17 extends from the shoulder because of the recess 23 and the beveled edge 19. Therefore, the examiner maintains that Timme satisfies the limitations of a "wear indicator that extends from a shoulder of the pin member".

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

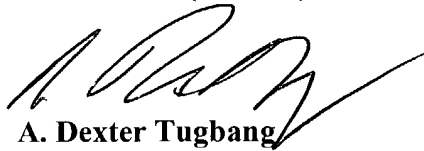
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
A. Dexter Tugbang  
Primary Examiner  
Art Unit 3729

May 7, 2004